

Handwritten signatures and date 11/27/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

DENNIS P. CURRAN ET AL.

Serial No.: 09/506,779

Filed: February 18, 2001

Art Unit: 1627

Examiner: Maurie E. Garcia

Atty Dock No.: 99-038

REACTION AND SEPARATION
METHODS

Pittsburgh, Pennsylvania 15219

November 20, 2001

Attention: Maurie E. Garcia

Commissioner for Patents
Washington, DC 20231

Sir:

CERTIFICATE OF TRANSMISSION
BY FAX

I hereby certify that this Response and the accompanying Petition for Extension are being transmitted by fax to the Commissioner for Patents, Washington D.C. 20231 at (703) 305-3704.

On November 20, 2001

Handwritten signature of Henry E. Bartony Jr.
Henry E. Bartony Jr.
Registration No. 34,772

RESPONSE

In the Office Action dated September 20, 2001 in the above-referenced application, the Examiner required restriction to one of the following asserted inventions under 35 U.S.C. Section 121:

- I. Claims 1 (in part), 2, 3, 10, 11-16 and 45, drawn to a method of separating compounds based upon difference in fluorous nature, classified in various classes/subclasses, for example, class 210, subclasses 656 or 690.

DENNIS P. CURRAN ET AL.
Serial No.: 09/506,779

2

- II. Claims 1 (in part), 4, 5, 10 and 45, drawn to a method of separating compounds based upon differences in total charge, classified in various classes/subclasses, for example, class 204, subclasses 450455 or class 210, subclass 656.
- III. Claims 1 (in part), 6, 7, 10 and 45, drawn to a method of separating compounds based upon differences in size, classified in various classes/subclasses, for example, class 210, subclasses 635, 649 or 654.
- IV. Claims 1 (in part), 8-10 and 45, drawn to a method of separating compounds based upon differences in polarity, classified in various classes/subclasses, for example, class 210, subclasses 638, 656 or 660.
- V. Claims 17-21 and 28-44, drawn to a method for carrying out a chemical reaction using fluorous tagging moieties, classified in various classes/subclasses depending on the compounds and tags, for example, class 570, subclasses 127-136.
- VI. Claims 17, 18, 22, 23 and 28-32, drawn to a method for carrying out a chemical reaction using tagging moieties differing in total charge, classified in various classes/subclasses depending on the compounds and tags, for example, class 564, subclasses 281-290.
- VII. Claims 17, 18, 24, 25 and 28-32, drawn to a method for carrying out a chemical reaction using oligomer, polymer or dendrimer tagging moieties, classified in various classes/subclasses depending on the compounds and tags, for example, class 528, subclasses 491-498.
- VIII. Claims 17, 18, 26, 27 and 28-32, drawn to a method for carrying out a chemical reaction using tagging moieties differing in polarity, classified in various classes/subclasses depending on the compounds and tags, for example, class 585, subclasses 16-27.

Applicants hereby elect with traverse Group I (Claims 1, 2, 3, 10, 11-16 and 45).

The Examiner is correct that different chemical/physical mechanisms for separation are used in each of the Groups of claims set forth by the Examiner. However, Applicants respectfully assert that the Examiner is incorrect that the "different methods [of the present invention] would require completely different searches in the patent and non-patent databases, and there is no expectation that the searches would be coextensive." In that regard, in each of the methods of the present invention involves the steps of

DENNIS P. CURRAN ET AL.
Serial No.: 09/506,779

3

tagging compounds with tagging moieties and separating those compounds or product compounds synthesized therefrom using a separation method based upon differences in the tagging moieties. Indeed, Applicants note that Claim 45 is common to Groups I-IV. In the interest of expedient prosecution and to prevent duplicative and unduly burdensome searches, Applicants respectfully request that the Examiner withdraw the restriction requirement and that the claims of Groups I-VIII be examined together.

However, even if the differences between the tagging/separation schemes of the present invention warranted restriction, which Applicant respectfully asserts that they do not, Groups I and V both utilize differences in the fluorine nature of tagging moieties or groups to effect separation. That the method of Group V includes "at least one chemical reaction" before the step of separation will not affect the scope of the search to be performed. In the alternative, therefore, Applicants respectfully request that the claims of Groups I and V be examined together.

In view of the above and remarks, the Applicants respectfully requests that the Examiner withdraw the restriction requirement set forth in the Office Action of September 20, 2001. In the alternative, the Applicants respectfully request that the Examiner withdraw the restriction requirement as applied to Groups I and V and that Groups I and V be examined together.

Respectfully submitted,

DENNIS P. CURRAN ET AL.

By



Henry E. Bartony, Jr., Esq.
Reg. No. 34,772

Bartony & Hare
Law & Finance Building
Suite 1801
429 Fourth Avenue
Pittsburgh, Pennsylvania 15219
412-338-8632 (telephone)
412-338-6611 (fax)

Attorney for Applicant



RESTRICTION ELECTION FACSIMILE TRANSMISSION

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FROM/ATTORNEY: Henry E. Bartony, Jr. (Reg. No. 34,772)

FIRM: Bartony & Hare

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PHONE NUMBER: 412/338-8632

TO EXAMINER: Maurie E. Garcia, Ph.D.

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FAX/TELECOPIER NUMBER: ~~(703) 305-3704~~ (703) 308-4242
(This number would not answer)

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COMMENTS: Attached are: 1. Petition for Extension of Time and 2. Response

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